

REMARKS

STATUS OF CLAIMS

Applicant has amended claim 10 and has added new claim 19. The claim amendment is supported by the as-filed specification, e.g., paragraphs [0026], [0031], [0083], [0093], [0104], and Examples 1-30. No new matter has been introduced. Claims 10-19 are currently pending.

§ 102(b) REJECTION

Applicant respectfully traverses the 35 U.S.C. § 102(b) rejection of claims 10-18 over U.S. Patent No. 6,300,292 to Konishi et al. ("Konishi").

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131.

Amended claim 10 recites, among other things, "at least one compound selected from the group consisting of dihydrocarbyl polysulfides, sulfidized esters, zinc dithiocarbamate compounds, molybdenum dithiophosphate compounds, molybdenum thiocarbamate, phosphoric acid esters, acidic phosphoric acid esters, acidic phosphoric acid ester amine salts, phosphorous acid esters, and phosphorothionates."

Konishi neither discloses nor suggests any of the above-mentioned compounds, as recited in amended claim 10.

Since Konishi fails to disclose all of the features of amended claim 10, amended claim 10 and its dependent claims are not anticipated by Konishi under § 102(b).

§ 103(a) REJECTIONS

Applicant respectfully traverses the 35 U.S.C. § 103(a) rejection of claims 10-18 over U.S. Patent No. 6,383,992 to Garmier et al. (“Garmier”) in view of Konishi, and the § 103(a) rejection of claims 15-18 over Konishi in view of U.S. Patent Application Publication No. 2002/0035043 to Yokota et al. (“Yokota”).

As discussed above, Konishi fails to disclose the above-quoted compounds of amended claim 10. Garmier also provides no disclosure or suggestion of any of the recited compounds, nor any suggestion of any need to add the recited compounds to its disclosed oil composition. Yokota discloses at paragraph [0084] that sulfuric- and phosphoric- extreme pressure additives may be added to the oil composition disclosed in Yokota; however, Yokota does not disclose or suggest any of the above-mentioned compounds recited in amended claim 10 that are absent from Konishi and Garmier, i.e., dihydrocarbyl polysulfides, sulfidized esters, zinc dithiocarbamate compounds, molybdenum dithiophosphate compounds, molybdenum thiocarbamate, phosphoric acid esters, acidic phosphoric acid esters, acidic phosphoric acid ester amine salts, phosphorous acid esters, and phosphorothionates. These elements of the claimed compound are not a combination of prior art elements according to known methods to yield predictable results, nor a simple substitution of known elements for others to obtain predictable results, nor application of a known technique to improve a similar device or method in the same way, nor a choice from a finite number of identified, predictable solutions with a reasonable expectation of success. See M.P.E.P. § 2143.

Furthermore, the claimed oil composition demonstrates the unexpected beneficial results that were not predicted in the cited references, as evidenced by the

Declaration of Satoshi SUDA under 37 C.F.R. § 1.132 (“Rule 132 Declaration”) filed

February 9, 2010.

“When considering whether proffered evidence is commensurate in scope with the claimed invention, Office personnel should not require the applicant to show unexpected results over the entire range of properties possessed by a chemical compound or composition.” M.P.E.P. 2145. Although Applicant submits that the claims prior to the amendment already were commensurate in scope with Examples of the claimed oil composition disclosed in the as-file specification, solely to advance prosecution, Applicant has amended claim 10 to more particularly point out the claimed subject matter.

As noted on page 8 of the Office Action, Examples 2 and 3 containing the oils for metal working according to amended claim 10 showed beneficial results such as higher abrasion resistance, as compared to oils wherein either a total degree of unsaturation of a triester is greater than 0.3 or a sulfur or phosphorus compound used in the oil is not one of the Markush group compounds recited in amended claim 10. See Rule 132 Declaration, pages 4-5.

The Office Action asserted that “applicants need to compare their results to the closest prior art which in this case would Konishi in order to show that the results are truly unexpected.” Office Action, page 8. Applicant respectfully submits that as shown on paragraph 9 of the Rule 132 Declaration, the base oils disclosed in Konishi are equivalent to the oils of the comparative examples exhibiting inferior properties, but Konishi neither discloses nor suggest the recited group of sulfuric and phosphorous compounds of amended claim 10, as discussed above. Accordingly, one of ordinary

skill in the art would not have reasonably expected successful results in abrasion resistance from Konishi's oil compositions. See M.P.E.P. § 2143.02. Moreover, Konishi neither discloses nor suggest an improvement in abrasion resistance from its oil compositions.

Neither Garmier nor Yokota discloses or suggests the features of amended claim 10 missing from Konishi, and fail to predict the above-discussed beneficial results.

Absent such teachings in the cited references, the use of one of the recited sulfur and phosphorous compounds would not have been one of a finite number of predictable solutions to solve the pertinent problems in oils for metal working, nor a simple substitution of one known element for another to obtain predictable results. See M.P.E.P. § 2143. Accordingly, it would not have been obvious to one of ordinary skill in the art at the time of invention to select one of the recited compounds.

For at least the above reasons, amended claim 10 is not obvious over the cited references. Claims 11-18 depend from claim 10 and incorporate all of the features of amended claim 10. Claims 11-18, therefore, also are not obvious at least due to their respective dependence from amended claim 10.

NEW CLAIM 19

New claim 19 recites, among other things, at least one compound selected from the group consisting of sulfidized esters and phosphoric acid esters. As discussed above, none of the cited references discloses or suggests any of the above-mentioned compounds of claim 19.

Claim 19 is also commensurate in scope with Examples 2 and 3 of the as-filed specification, thus parallel to the scope of the above-discussed unexpected beneficial results, also as shown in the Rule 132 Declaration.

Accordingly, claim 19 also is allowable over the cited references.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application, withdrawal of the rejections, and timely allowance of the pending claims.

The Examiner is invited to contact Applicant's representative if there are any remaining issues.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: /Hojung Cho/
Hojung Cho
Ltd. Rec. No. L0596
(202) 408-4457